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09/784,994	02/14/2001	Tatsuru Kuwabara	12894/003001/55713-US-TO/	4046

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EXAMINER

GOLD, AVI M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,994

Applicant(s)

KUWABARA, TATSURU

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the application filed February 14, 2001. Claims 1-16 are pending. Claims 1-16 represent a client server system for mobile phone.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 16 provides for the use of the mobile phone in the client server system, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by An et al., U.S. Patent No. 6,031,904.

An teaches the invention as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

Regarding claim 1, a client server system for supplying information to client terminals, the client server system comprising:

an exclusive server storing information therein (col. 1, lines 31-40; An discloses a telephone service providers server);

means for specifying the client terminal by a code identifying a maker of the client terminal, the code being sent from the client terminal to the exclusive server (col. 1, lines 31-40; An discloses a "telephone feature profile" accessed by a personal identification number); and

means for supplying information stored in the exclusive server to the specified client terminal (col. 1, lines 54-67; col. 2, lines 1-11; An discloses a server connected to an information communications network).

Regarding claim 2, the client server system as in claim 1, wherein:

the supplying means rejects access to the exclusive server against an unspecified client terminal (col. 1, lines 54-67; col. 2, lines 1-11; An discloses subscribers receiving access to the server).

Regarding claim 3, the client. Server system as in claim 1, wherein:

the exclusive server stores information exclusive to the specified client terminals and public information (col. 1, lines 31-40, lines 54-67; col. 2, lines 1-11; An discloses a personal telephone feature profile and general information such as monthly costs); and

the supplying means supplies the exclusive information only to the specified client terminals, while supplying the public information to any client terminals (col. 1, lines 31-40, lines 54-67; col. 2, lines 1-11; An discloses a personal profile only available by a personal identification number and general information available over the Internet for the public).

Regarding claim 8, a client server system for supplying information to client terminals, the client server system comprising:

an exclusive server storing specified contents to be supplied to the client terminals (col. 1, lines 31-40);

means for downloading the specified contents stored in the exclusive server to the client terminals, wherein:

the specified contents are accompanied by a special command (col. 1, lines 31-40, lines 54-67; col. 2, lines 1-11; An discloses that profile features can be changed, added, or deleted);

the specified contents are downloaded together with the special command (col. 1, lines 31-40, lines 54-67; col. 2, lines 1-11, lines 19-26; An discloses a subscriber receiving changes through an access unit); and

upon receipt of the special command, a setting of the client terminals recognized as specified terminals by the exclusive server is changed (col. 1, lines 31-40, lines 54-67; col. 2, lines 1-11, lines 19-26, lines 35-42; An discloses a server making changes to a profile).

Regarding claim 9, the client server system as in claim 8, wherein:

data for changing the setting of the specified terminal are downloaded from the exclusive server (col. 1, lines 31-40, lines 54-67; col. 2, lines 2-11).

Regarding claim 10, the client server system as in claim 9, wherein:

the data for changing the setting are downloaded together with the special command (col. 1, lines 31-40, lines 54-67; col. 2, lines 2-11, lines 19-26).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over An further in view of Fujiwara et al., U.S. Patent No. 6,064,879.

An teaches the invention substantially as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

As to claim 4, An teaches the method of claim 1.

An discloses the phone sending the maker-identifying code and another code identifying the provider to the provider's server (col. 1, lines 54-67; col. 2, lines 1-11; An discloses a profile stored for a specific DN (directory number) and the use of a personal identification number);

a data format including both identifying codes is sent from the provider's server to the exclusive server (col. 1, lines 54-67; col. 2, lines 1-11); and

the exclusive server supplies the information stored therein to the mobile phone only when both codes are justified as codes correctly identifying the maker and the provider (col. 1, lines 54-67; col. 2, lines 1-11; An discloses the features being accessed only with the use of a DN and PIN).

An fails to teach the limitation further including the client terminals are mobile telephones.

However, Fujiwara teaches a mobile communication method suitable for a purchased mobile unit system (see abstract). Fujiwara shows evidence of the use of mobile phones receiving exclusive information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An in view of Fujiwara to use a mobile phone as a client terminal. One would be motivated to do so because it would allow exclusive information on a portable device.

As to claim 6, An discloses a phone communicable with an exclusive server administered by a maker which made the phone, the phone comprising:

a pre-installed locator for locating the exclusive server to download contents stored in the exclusive server and made available only to the phone having the locator (col. 5, lines 5-21, lines 66-67; col. 2, lines 1-17; An discloses the use of a unique URL to access a server with content)

An fails to teach the limitation further including the phones are mobile phones.

However, Fujiwara shows evidence of the use of mobile phones receiving exclusive information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An in view of Fujiwara to use a mobile phone. One would be motivated to do so because it would allow exclusive information on a portable device.

As to claims 12 and 16, An teaches the method of claim 8.

An fails to teach the limitation further including the client terminals are mobile phone.

However, Fujiwara shows evidence of the use of mobile phones receiving exclusive information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An in view of Fujiwara to use a mobile phone as a client terminal. One would be motivated to do so because it would allow exclusive information on a portable device.

Claim 16 does not teach or define any new limitations above claim 12 and therefore is rejected for similar reasons.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over An and Fujiwara further in view of Lawande et al., U.S. Patent No. 6,219,697.

An teaches the invention as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

Fujiwara teaches the invention as claimed including a mobile communication method suitable for a purchased mobile unit system (see abstract).

As to claim 5, An and Fujiwara teaches the method of claim 4.

An and Fujiwara fail to teach the limitation further including the use of a header field and a data field which includes the maker-identifying code.

However, Lawande teaches a method and apparatus for operating IP protocol over a high-speed bus such as an IEEE 1394 high-speed bus (see abstract). Lawande teaches the use of header field, data field, and a company ID in a field (col. 17, lines 14-44; col. 18, lines 41-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An and Fujiwara in view of Lawande to use a header field and a data field which includes the maker-identifying code. One would be motivated to do so because they would help prohibit unauthorized access to the exclusive server.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over An further in view of Hayashi, U.S. Patent No. 6,650,913.

An teaches the invention substantially as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

An discloses an exclusive server made available exclusively to the phone

An fails to teach the limitation further including a browser for downloading the content in the exclusive server.

However, Hayashi teaches an a folding mobile telephone unit that enables the user to capture an HTML (hypertext markup language) file from a Web server, analyze the file, and view the results of the analysis (see abstract). Hayashi shows evidence of the use of a web browser on a mobile phone.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An in view of Hayashi to use a mobile phone with a web browser for downloading the content in the exclusive server. One would be motivated to do so because a browser would allow for the content to be displayed on a mobile phone.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over An further in view of Lawande et al., U.S. Patent No. 6,219,697.

An teaches the invention as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

As to claim 11, An teaches the method of claim 8.

An fails to teach the limitation further including the use of a header field and data field, with the special command in the header field.

However, Lawande teaches a method and apparatus for operating IP protocol over a high-speed bus such as an IEEE 1394 high-speed bus (see abstract). Lawande teaches the use of a header field and data field (col. 17, lines 14-44; col. 18, lines 41-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An in view of Lawande to use a header field and data field, with the special command in the header field. One would be motivated to do so because they would help prohibit unauthorized access to the exclusive server and the special

command in the header field would allow for the client to make the requested changes immediately.

11. Claims 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over An and Fujiwara further in view of Marshall, U.S. Patent No. 6,735,487.

An teaches the invention as claimed including a system which permits a subscriber to add/change or delete features with respect to his/her particular telephone feature profile (see abstract).

Fujiwara teaches the invention as claimed including a mobile communication method suitable for a purchased mobile unit system (see abstract).

As to claim 13, An and Fujiwara teach the method of claim 12.

An and Fujiwara fail to teach the limitation further including the use of a display panel with images to change settings.

However, Marshall teaches an interactive wagering system with promotions (see abstract). Marshall teaches the use of selecting menu option on a display to interact with a wagering service (col. 15, lines 11-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An and Fujiwara in view of Marshall to use a display panel with images to change settings. One would be motivated to do so because it allows changes to be made visually and accurately.

As to claim 14, An and Fujiwara teach the method of claim 12.

An and Fujiwara fail to teach the limitation further including the use of a display panel with character messages to change settings.

However, Marshall teaches the use of messages on the display for a user to sign up for options (col. 19, lines 27-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An and Fujiwara in view of Marshall to use a display panel with character messages to change settings. One would be motivated to do so because it allows changes to be made visually and more accurately.

As to claim 15, An and Fujiwara teach the method of claim 12.

An and Fujiwara fail to teach the limitation further including a sound generator for outputting music which can be changed to change setting of the mobile phone.

However, Marshall teaches the use of music that can be changed if other audio needs to be played (col. 23, lines 62-67; col. 24, lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify An and Fujiwara in view of Marshall to use a sound generator for outputting music which can be changed to change setting of the mobile phone. One would be motivated to do so because it allows changes to be made regarding the music outputted on the phone.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,259,405 to Stewart et al.

U.S. Pat. No. 6,363,061 to Yuzawa.

U.S. Pat. No. 6,584,095 to Jacobi et al.

U.S. Pat. No. 6,480,833 to Tsutsumitake.

U.S. Pat. No. 6,138,044 to McGregor et al.

U.S. Pat. No. 5,974,311 to Lipsit.

U.S. Pat. No. 5,524,135 to Mizikovsky et al.

U.S. Pat. No. 5,948,066 to Whalen et al.

U.S. Pat. No. 6,223,291 to Puhl et al.

U.S. Pat. No. 6,115,471 to Oki et al.

U.S. Pat. No. 6,725,033 to Holmes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 703-305-8762. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

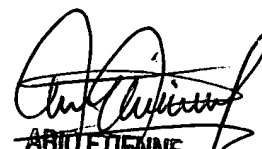
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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